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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,179	06/20/2000	Maura Rooney	BSP2102US02	5883
22852	7590	01/09/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/597,179

Applicant(s)

ROONEY ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22,25,28-30,32-39,57,58,60-89,96 and 98-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28,29,32,38,57,58,60,62-89,96 and 98-116 is/are allowed.
- 6) ☒ Claim(s) 22,25,30,33-37,39 and 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/5/07 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regard as his invention.

3. Claims 22, 25, 30, 34 – 37 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention. In regard to claim 22, line 5 states “composed of a second material”. However, no first material is set forth, so it is unclear what is meant by a second material.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22, 25, 30 and 33 - 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08257136 A to Asano et al. in view of U.S. Patent No. 4,984,581 to Stice and U.S. Patent No. 4,763,647 to Gambale.

In regard to claims 22, 25, 30 and 33 - 37, Asano et al. discloses a guide wire including an elongate core (11) including a proximal end and a distal end and a length having a constant diameter (Figure 8); a continuous, unitary coil (21) exhibiting an outer diameter and an inner diameter, composed of a second material [0031], surrounding a portion of the core, and extending beyond the distal end of the core by a plurality of turns of the coil (Figure 8); and a polymeric tip (12) contacting and extending from a distal portion of the coil, wherein the tip connects to the core by a polymeric material provided within spaces between adjacent turns of the coil such that the polymeric material encloses at least an area inside the inner diameter of the coil and up to the outer diameter of the coil. Asano et al. discloses the second material comprising stainless steel [0031]. The distal portion of the core is tapered (11a). The polymeric tip includes a radio-opaque material [0030]. The coil includes a coating. Asano et al. discloses the coating being lubricious [0018]. Asano et al. discloses the coating being colored [0013]. The coil has a circular cross-section. Asano et al. discloses the core being composed of a shape memory alloy [0016], but fails to disclose the shape memory alloy being a nickel-titanium alloy. Additionally, Asano et al. fails to disclose the coil surrounding the entire length of the core or having a rectangular cross-section. However, Stice discloses a guidewire having a shape memory alloy core comprising a nickel-titanium alloy (Col. 3, lines 42 – 51). Stice also discloses a coil being located only at the tip or extending the entire length of the core (Col. 2, lines 49 – 51) and having a rectangular cross-section (Col. 2, lines 44 – 49). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the core as

disclosed by Asano et al. to include nickel-titanium as taught by Stice in order to allow the guide wire to deform under stress as it is moved through curved body channels, and recover to a strait configuration when the stress is removed (Col. 3, lines 56 – 62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil as disclosed by Asano et al. to include a coil as taught by Stice in that Stice discloses a coil surrounding a portion of the core and a coil surrounding the entire core and a coil having circular and rectangular cross-section (Col. 2, lines 44 – 49) as being functionally equivalent and therefor interchangeable.

Additionally, Asano et al. fails to disclose the coil having a pitch that varies and the plurality of turns including non-contacting adjacent turns defining spaces extending to an outer diameter of the adjacent turns such that the polymeric material entirely fills the spaces between the adjacent turns.

Gambale discloses a guide wire having an elongate core and a coil surrounding a portion of the core. Gambale teaches varying the flexibility characteristics by providing the coil with a pitch that varies (Col. 3, lines 52 – 61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil as disclosed by Asano et al. to include a pitch that varies in order to arrive at a desired flexibility of the distal end region (Col. 3, lines 52 – 61). By modifying the pitch of the coil, at least three turns of the coil would extend beyond the distal end of the core and spaces would be created between adjacent turns of the coil that would be filled by polymeric material (12) when immersed into the resin liquid [0032].

6. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08257136 A to Asano et al. in view of U.S. Patent No. 4,984,581 to Stice and US Patent No. 4,763,647 to Gambale as applied to claims 22, 57, 70 and 84 above, and further in view of U.S. Patent No. 5,174,302 to Palmer.

In regard to claim 39, Asano et al. in view of Stice and Gambale disclose a unitary coil (21) but fail to disclose the unitary coil comprising a multifilar wire. However, Palmer discloses a unitary coil comprising a multifilar wire (Col. 4, lines 17 – 27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil as disclosed by Asano et al. in view of Stice and Gambale to include a multifilar wire coil as taught by Palmer in order to create intermittent bands or regions of high radiopaqueness (Col. 4, lines 25 – 26) to aid in the visualization of the guidewire during a medical procedure.

7. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08257136 A to Asano et al. in view of U.S. Patent No. 4,984,581 to Stice and U.S. Patent No. 4,763,647 to Gambale and U.S. Patent No. 5,947,940 to Beisel.

In regard to claim 61, Asano et al. discloses a guide wire including an elongate core (11) including a proximal end and a distal end and a length having a constant diameter (Figure 8); a continuous, unitary coil (21) exhibiting an outer diameter and an inner diameter, composed of a second material [0031], surrounding a portion of the core, and extending beyond the distal end of the core by a plurality of turns of the coil (Figure 8); and a polymeric tip (12) contacting and extending from a distal portion of the coil, wherein the tip connects to the core by a polymeric material provided within spaces between adjacent turns of the coil such that the polymeric material encloses at least an area inside the inner diameter of the coil and up to the outer diameter of the coil [0032]. Asano et al. discloses the core being composed of a shape memory alloy [0016], but fails to disclose the shape memory alloy being a nickel-titanium alloy. However, Stice discloses a guidewire having a shape memory alloy core comprising a nickel-titanium alloy (Col. 3, lines 42 – 51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the core as disclosed by Asano et al. to include nickel-titanium as taught by Stice in order

to allow the guide wire to deform under stress as it is moved through curved body channels, and recover to a strait configuration when the stress is removed (Col. 3, lines 56 – 62). Additionally, Asano et al. fails to disclose the plurality of turns of the coil including non-contacting adjacent turns defining spaces extending to an outer diameter of the adjacent turns such that the polymeric material entirely fills the spaces between the adjacent turns. Gambale discloses a guide wire having an elongate core and a coil surrounding a portion of the core. Gambale teaches varying the flexibility characteristics by providing the coil with spaces between adjacent turns of the coil (Col. 3, lines 52 – 61). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil as disclosed by Asano et al. to include spaces in order to arrive at a desired flexibility of the distal end region (Col. 3, lines 52 – 61). By modifying the spacing, at least three turns of the coil would extend beyond the distal end of the core and the spaces between adjacent turns of the coil would be filled by polymeric material when immersed in the liquid resin [0032]. Asano et al. fails to disclose the second material comprising a precipitation hardened alloy. Beisel discloses a guide wire including a precipitation hardened alloy as the coil material for aiding guide wire insertion into a patient. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the coil of Asano et al. to include the precipitation hardened alloy as taught by Beisel to increase the coil stiffness and enhance torqueability. Furthermore, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

***Allowable Subject Matter***

8. Claims 28, 29, 32, 38, 57, 58, 60, 62 - 89, 96 and 98 - 116 are allowed.

***Response to Arguments***

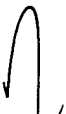
9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JMLF

